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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: BOX PETITIONS
Peter Holscher et al. Examiner: Ford, J.
Serial No.: 09/787,396 Group Art Unit: 1624
Filed: March 19, 2001 VIA FACSIMILE: 703-308-6916
Title: BENZOXAZINE AND BENZOTHAZINE DERIVATIVES AND THEIR USE
IN MEDICINES

#18
PetitionPETITION UNDER 37 C.F.R. § 1.181

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Assistant Commissioner for Patents
Washington, D.C. 20231

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PETITIONS OFFICE

Sir:

In response to the Office Action dated March 18, 2003, Applicant's elect not to cancel the non-elected claims and Applicants also petition the Commissioner to direct the Examiner to examine claims 11-15.

The claims withdrawn from consideration as allegedly directed to non-elected subject matter were improperly withdrawn, or are properly rejoinable, or do not pose an undue burden on the PTO to be examined.

Claim 11 is directed to a pharmaceutical composition that contains a compound of allowed claim 1 and one or more auxiliaries. A composition that comprises an allowable compound of claim 1 is also allowable. There is no reason why claim 11 would be found not allowable.

Furthermore, the subject matter of claim 11 is a combination of the allowed subject matter and other components, i.e., auxiliaries. As such, it is respectfully submitted that the pharmaceutical composition and the allowed compounds are related as subcombination-combination. Since they are related as combination-subcombination, the standard for requiring restriction herein was never met.

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e. separate classification, status, or field of search. See MPEP §808.02. If it can be shown that a combination, as

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DATE: 4-15-2003

claimed

(1) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

(M.P.E.P. §806.05(c))

It is submitted that at least the first requirement for two-way distinctness was not established.

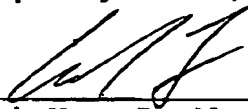
The combination does require the particulars of the subcombination. The pharmaceutical composition clearly requires the presence of a compound of allowed claim 1. The combination claim is even dependent upon subcombination-compound claim 1, and the subcombination-compound is an essential distinguishing feature of the combination-compositions.

Claim 12 and 13 are directed to a method of use and Claim 14 is directed to a process for preparing a compound of allowed claim 1. MPEP § 821.04 states that "if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims which either depend from or include all the limitations of the allowable product will be rejoined." The process claims in the above quoted language clearly refer to processes "for making and/or using the product." See MPEP § 821.04. Thus, rejoinder of claims 12-14 is proper and actually mandated by the MPEP.

Claim 15 is directed to intermediates in the preparation process of the compounds of claim 1. If claim 14, i.e., the claim directed to a process for preparing the compounds of claim 1, is examined, which it should be as discussed above, it would pose no undue burden on the Patent Office to examine the claim directed to the intermediates that are also recited in the process claim.

No fee is believed to be due with this response; however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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